

**REMARKS/ARGUMENTS**

This Amendment and Response to Office Action is filed in response to the Office Action of November 3, 2003. Presently, all of the pending claims (1-20) stand rejected for the following reasons:

- Claims 1-11 and 15-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S.P.N. 5,990,918 to Baxendale (“Baxendale”) and U.S.P.N. 4,897,533 to Lyszczarz (“Lyszczarz”); and
- Claims 12-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Baxendale as modified by Lyszczarz as applied to claim 1, and further in view of U.S.P.N. 5,688,056 to Peyret (“Peyret”).

Since this Office Action was mailed on November 3, 2003, a response to the Office Action is not due until February 3, 2004. No extension of time is therefore required to accompany this filing. By this Amendment, independent claims 1 and 16 have been amended to place them in condition for allowance. Applicant asserts that these claim amendments are fully supported by the Application as filed and, as such, do not introduce new matter.

**A. Rejection of Claims 1-11 and 15-20 under 35 U.S.C. §103(a) as being Obvious over the Combination of Baxendale with Lyszczarz**

Claims 1-11 and 15-20 currently stand rejected under 35 U.S.C. §103 as being unpatentable over Baxendale in view of Lyszczarz. These rejections are traversed based on the following.

To properly reject a claim under 35 U.S.C. §103(a), the Manual of Patent Examining Procedure imposes a burden on the Patent Office to establish a *prima facie* case of obviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.

M.P.E.P § 2142. There are three basic criteria to a case of prima facie obviousness: i) there must be some suggestion or motivation to modify the references or combine the reference teachings; ii) there must be reasonable expectation of success in modifying or combining the references; and iii) the prior art references must disclose or suggest all of the limitations of the claimed invention. *Id.* In the present case, the Office Action has failed to establish, at a minimum, a teaching of all of the limitations of the claimed invention.

Neither Baxendale nor Lyszczarz disclose or suggest a “substrate having a reflective region covering a portion of the substrate substantially less than the entire surface of the substrate” as required by amended claim 1. Indeed, the Office Action admits that “Baxendale fails to teach the substrate having a reflective region covering a portion of the substrate.” Regarding the Lyszczarz reference, the Office Action alleges that “Lyszczarz teaches a method and an item comprising: providing a layer of plastics material (4) over a substrate (2), the substrate having a reflective region (3) covering a portion of the substrate.” The Lyszczarz reference, however, teaches a substrate where the entire surface of the substrate must be covered with a reflective material: “The metal containing layer is bonded to the first surface of the substrate and preferably covers at least substantially the entire first surface of the substrate.” Lyszczarz, col. 2, lns. 58-61 (emphasis added). In the recent Request for Continued Examination, Applicant therefore argued that Lyszczarz taught away from the requirement of covering only a portion of the substrate. The Examiner, however, was unpersuaded:

While the claims recite that a reflective region covers ‘a portion’ of the substrate, there is nothing in the claims that precludes the reflective region from covering the entire substrate. A reflective region that covers the entire substrate also, by necessity, covers a ‘portion’ of the substrate. Thus, the teachings of Lyszczarz meet the claimed limitation.

Office Action, p. 6. To overcome this objection, Applicant has clarified this limitation by adding the requirement that the reflective region cover a portion of the substrate that is “substantially less than the entire surface of the substrate.” Since none of the cited references disclose or suggest a “substrate having a reflective region covering a portion of the substrate substantially less than the entire surface of the substrate,” the combination of Baxendale with Lyszczarz cannot render independent claim 1 obvious. Since claims 2-11 and 15 depend from claim 1, these claims distinguish from the combination of Baxendale and Lyszczarz for the same reasons as claim 1. For these reasons, Applicant requests that the rejection of claims 1-11 and 15 as being obvious over the combination of Baxendale with Lyszczarz be reconsidered and withdrawn.

Much like claim 1, claim 16 has been amended to clarify that that reflective element is substantially less than the entire surface of the substrate and that the reflective element comprises a metal film suitable for increasing the visibility of an overlying security image. Since these amendments are substantially similar to the amendments of claim 1, claim 16 distinguishes from Baxendale and Lyszczarz for the same reasons as claim 1. Further, since claims 17-20 depend from claim 16, these claims distinguish from the combination of Baxendale and Lyszczarz for the same reasons as claim 16. For these reasons, Applicant requests that the rejection of claims 16-20 as being obvious over the combination of Baxendale with Lyszczarz be reconsidered and withdrawn.

Claims 12-14 are also rejected under 35 U.S.C. §103 as being unpatentable over Baxendale in view of Lyszczarz as applied to claim 1, and further in view of Peyret (US 5,688,056). Because each of these claims depend from independent claim 1, which has been distinguished over Baxendale and Lyszczarz, Applicant submits that the rejection of these claims

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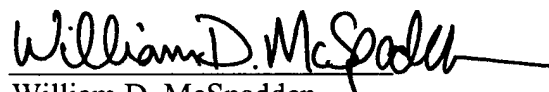
has been traversed. Applicant therefore requests that the rejection of claims 12-14 be reconsidered and withdrawn.

### CONCLUSION

Applicant respectfully submits that pending claims 1-20 are in condition for allowance, and requests a Notice of Allowance for the pending claims. Examiner is invited to contact the undersigned Attorney of Record if such would expedite the prosecution of the present Application. Applicant has enclosed a check in the amount of \$110.00 to accommodate the fee for Petition for Extension of Time under One Month to respond to office action. The Commissioner is hereby authorized to charge any deficient fees to complete this filing or credit any overcharge to Deposit Account No. 13-0480, referencing Attorney Docket Number 24141761.2RCE.

Respectfully submitted,

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